



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,449	02/18/2000	Akira Ishikura	1701.86409	8178

22907 7590 07/02/2004

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

SHARMA, SUJATHA R

ART UNIT	PAPER NUMBER
----------	--------------

2684

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,449

Applicant(s)

ISHIKURA ET AL.

Examiner

Sujatha Sharma

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,18,28,34,38 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,19,23,35,39,40 is/are allowed.
- 6) ☒ Claim(s) 5,18,28,34,38 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 14.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 5,18,28,34,38,41 are rejected under 35 U.S.C. 102(e) as being anticipated by Metso [US 5,920,826].

Regarding claims 5,18,28,34,38 and 41, Metso discloses a radiotelephone text transmission system. Metso discloses a phone configured to be connected to a base station via a radio channel. (See col.2, lines 30-37). Metso further discloses a control unit (504 in fig.5) for controlling the phone and a modem (312 in fig.3) for connecting the control unit and the phone (See fig.4). Metso further discloses a method where the communication apparatus is operated in one of first mode of communicating with a base station and a second mode in which the control unit controls the radio communication (See summary of invention, Fig. 4 and Fig. 6 and col. 7, line 24 – col.

Art Unit: 2684

8, line 38). Metso further discloses a method where the phone transmits the status information to the data terminal and is displayed on the data terminal (See summary of invention and Fig.6 where the signal strength and battery status information is displayed while the phone is in the first mode i.e. controlling communication with a base station).

Response to Arguments

Applicant's arguments filed 5/3/04 have been fully considered but they are not persuasive.

The applicant argues that Metso's invention does not teach a phone comprises a transmitter to "transmit status information of the phone to the data terminal when the communication apparatus is operated in the first mode".

The applicant is again drawn to the Metso reference Fig. 6 and col. 8, lines 18-38. Fig. 6 shows a display of the front panel of the phone on the data terminal. As indicated in col. 8, lines 18-38, when the call button on the data terminal is pressed, a call is initiated, using the data terminal, between the phone and the base station which is in fact the first mode i.e. the phone in control of the radio communication. Further, Fig. 6 also displays the signal strength and battery indication, which is possible when the phone is in the first mode i.e. controlling the radio communication with the base station.

The examiner would like to point that according to the language of the claim, the second mode is encompassing the first mode because communication between the phone and the base station are controlled by the phone in spite that the origination command is from either the phone or the data terminal.

Allowable Subject Matter

1. The following is an examiner's statement of reasons for allowance:

The following is an examiner's statement of reasons for allowance of claims 6,19,23,35,39 and 40.

Lazaridis [US 5,657,345] is the closest prior art to the applicant's invention, which discloses a computer system for use with a wireless data communications network. Lazaridis discloses a method of transferring information from a wireless network to a portable computer via mobile phone. Further the mobile communication device is in communication with a radio network. However Lazaridis does not disclose a method of transferring the status information from the terminal equipment such as the computer to the communication equipment such as the hand held phone and displaying the status information in the hand held unit display. Therefore the claims 6,19,23 and 35,39 and 40 are allowed since the prior art does not disclose a method of transferring the status information from the terminal equipment to the mobile device for displaying to the user such status information on the mobile unit display.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after


Art Unit: 2684

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sujatha Sharma whose telephone number is 703-305-5298. The examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sujatha Sharma
June 17, 2004


NAY MAUNG
SUPERVISORY PATENT EXAMINER